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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/016,002 | 01/30/1998 | DAVID S. LAMPERT | 7117-89 | 6408 |

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07/12/2005

NAVIGATION TECHNOLOGIES CORPORATION
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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/016,002 | Applicant(s) DAVID S. LAMPERT | |
| | Examiner Ella Colbert | Art Unit 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>13 October 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 2-20 and 23-29 are pending in this communication filed 10/13/04 entered as Request for Continued Examination after a BAPI decision.
2. The IDS filed 06/17/04 has been reviewed and considered.
3. The Drawings filed 10/13/04 have been reviewed and considered.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/04 has been entered.

Claim Rejections - 35 USC § 101

5. Claims 23, 24, 25, and 26 and claims 2-10, 13-15, and 17 that depend there from are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural/functional interrelationship which can only be computer implemented is considered to have a

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technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) –used only for content and reasoning since not precedential]. Claim 26 is simply data per se and needs to be placed on a medium like claim 27 to overcome the 35 U.S.C. 101 rejection. Claim 26 is considered data per se needs to be put on a medium like claim 27.

Claim Rejections - 35 USC § 102

6. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,968,109) Israni et al, hereafter Israni.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

With respect to claim 27, Israni teaches, (a) data entities each of which represents a geographic feature in a geographic region (col. 5, lines 29-45 and line 64 – col. 6, line 67), wherein the data entities are separated into a plurality of parcels (col. 7, lines 61-col. 8, line 50), wherein each parcel contains a subset of the data entities (col. 8, line 51-col. 9, line 15), wherein the subset of data entities in each parcel represents

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those geographic features ... wherein an improvement comprises: (col. 10, lines 11 –col. 11, line 46), (b) a plurality of indexes, each of which is associated with a separate one of the plurality of parcels and where the index relates each of the data entities in the subset of data entities ... (col. 10, lines 11 –col. 11, line 46), and the geographic database is stored on a computer readable storage medium (col. 19, lines 23 –col. 20, line 64).

With respect to claim 28, Israni teaches, wherein said data entities represent segments of roads (col. 6, lines 36-63)

With respect to claim 29, Israni teaches, a plurality of parcels, each of which contains a separate portion of the data records, ... (col. 21, line 45 –col. 22, line 18 and col. 24, line 23 –col. 25, line 61), wherein an improvement comprises: a plurality of first indexes each of which is associated with a plurality of parcels, ... (col. 19, line 23-col. 20, line 64), and the computer readable data structure means identifies which of the data records represent segments of roads located in any specified sub-area of any specified area (col. 28, lines 43 –col. 29, line 11).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tamai et al (US 5,731,978) disclosed vehicle navigation through recognition of geographical region types in a map database.

Shinsangyokaihatu, Kabushiki Kaisha et al (EPO 0330787 A2) disclosed a navigation system that may be a CD storing data representing a standard map of a particular area that is required for guidance.

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Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
June 25, 2005